

REMARKS

This Response is submitted in response to the second Office Action mailed January 24, 2003, for the above-identified patent application. Claims 1-6, 8 and 12-22 are pending. Claims 1-6, 8 and 12-22 are have been rejected for obviousness-type double patenting over claims 1-21 of U.S. Patent No. 6,114,365 because the species of the '365 patent anticipate the compounds of the claims of this Application when the R1 group thereof is optionally substituted.

The Office Action rejects the claims of this Application on the basis of a one-way test for obviousness-type double patenting over the claims of U.S. Patent No. 6,114,365 (hereafter "the '365 patent"). Applicant hereby respectfully submits that this Application – due to the relationship of it and its claims to that of the '365 patent specification and claims – is legally entitled to an application of the two-way test to determine the legal propriety of an obviousness-type double patenting rejection.

As will be explained in greater detail below, this Application claims a genus invention whereas the '365 patent claims a species invention wherein some compounds of which fall within the genus of this Application. This Application is a basic invention compared to the later discovered species invention of the '365 patent. The Applicant followed normal filing practices and time lines and no abnormal delays were caused by Applicant in the prosecution of this U.S. national phase application. The priority filing date of this Application for the basic invention is well before the earliest filing date entitlement of the '365 patent. Although this Application and the '365 patent are commonly owned, the species improvement invention claimed by the '365 patent could not have been claimed in the UK priority application which lead to this basic invention Application, because the inventorship is not the same.

By way of introductory conclusion, Applicant submits that the obviousness type double patenting rejection is improper at least because (1) this Application, as compared to the '365 patent, is a basic genus invention having the earliest priority date; (2) the '365 patent claims a species invention encompassed by the genus claims of this Application; (3) the species claims of the '365 patent have not been demonstrated to be *prima facie* obvious over the claims of this Application; and (4) this Application has matured from a normal and conventional time filing sequence with no abnormal delays in the

maturity/prosecution thereof due to Applicant's actions. Under these conditions, this Application is legally entitled to be tested for obviousness-type double patenting by the "two-way" test of *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289, (Fed. Cir. 1991).

The Relationship Between This Application and the '365 Patent

The instant application claims priority to United Kingdom Application 9823871.0 filed October 30, 1998 through PCT/EP99/08306, which was filed October 27, 1999 claiming priority to the earlier filed UK application. The PCT application was converted to the instant U.S. Application 09/807,962, filed April 26, 2001.

The '365 patent is cited as a basis for rejection of claims 1-5, 6, 8, 15-22, 12, 13 and 14 for obviousness-type double patenting over claims 10-21, 1-5, 6-8 and 9 of the '365 patent. The earliest claimed priority date of the '365 patent is its U.S. filing date of August 12, 1999 and the '365 patent issued September 5, 2000.

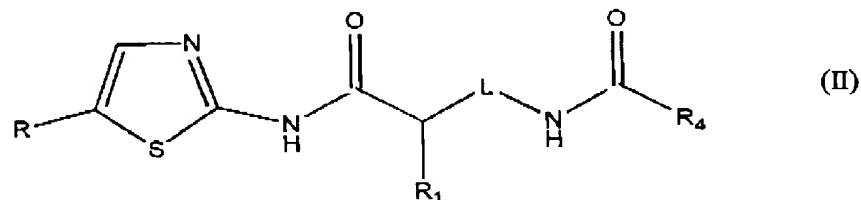
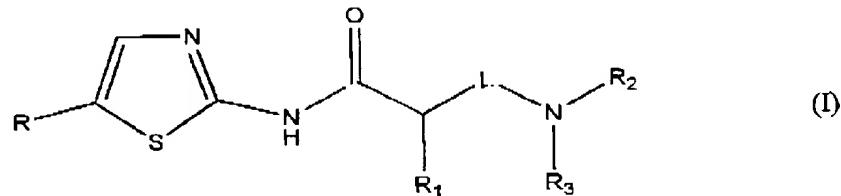
The '365 patent issued about seven months before the U.S. National phase application here involved matured. The filing sequence of the instant application is well within the time limits under the Paris Convention and the PCT procedures, meaning there has been no undue delay of the U.S. national application caused by Applicant. A first Office Action issued June 27, 2002 to which, with a two month extension of time, an Amendment was filed November 20, 2002. Thereafter a second Office Action issued January 24, 2003 which for the first time stated the current basis for obviousness-type double patenting rejection over certain claims of the '365 patent.

The '365 patent will expire August 12, 2019. Without the filing of a terminal disclaimer in this Application, the patent to issue from this case has a potential life span extending to April 26, 2021, which is almost two years more than that of the '365 patent.

The Relationship Between the Claims

Claim 1 of the '365 patent is, in relevant part, as follows:

1. A 2-amino-1,3-thiazole derivative represented by formula (I) or (II):



wherein L is a phenyl group or a 5 or 6 membered aromatic heterocycle with one or more heteroatoms selected from the group consisting of nitrogen, oxygen and sulfur;

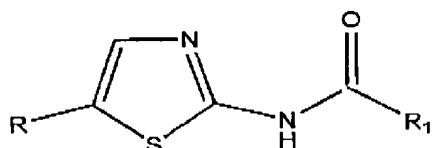
R is

- (i) . . .
- (ii) . . .
- (iii) . . .
- (iv) a straight or branched C₁ - C₆ alkyl group . . .
- (v) . . .

R₁ is a hydrogen atom; . . .

R₂ and R₃, which may be the same or different, are a hydrogen atom, . . .

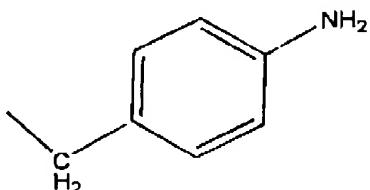
The instant Application claims compounds of the formula:



wherein R is isopropyl and "R₁ is an optionally substituted group selected from (i) straight or branched C₁-C₈ alkyl" Per the description of the specification of this application at page 10, line 24-page 11, line 10 the R₁ group may be optionally substituted by an aryl group (page 10, line 29) and according to the description of this specification at page 11, lines 10-13 such aryl group may be further substituted by carbonylamino group (page 10, line 32).

Accordingly, if R₁ is a C₂ alkyl group and if that C₂ alkyl is substituted with a phenyl group (an aryl group) and if the phenyl group is itself substituted with by carbonylamino group, then with this particular selection of first and second optional

substitutions, one can produce the formula (I) compound claimed in the '365 patent. The R₁ group of these claims would then have the following formula:



Thus, it can be seen that the claims of this Application are basic or genus claims as compared to the claims of the '365 patent, which in limited situations include compounds which are but an improvement or species of the compounds embraced by the genus claims of this application. Although the ownership of the '365 patent and this Application is common, the improvement or species claims of the '365 patent could not have been presented in this Application because the inventorship of the '365 patent is not identical to the inventorship of the priority UK application from which this Application stems. The timing of the priority application of the '365 patent and this Application clearly shows that this application describes the basic invention as to which the '365 patent is an improvement invention.

The "Two-Way" Determination of Braat Is Applicable Here

In *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991) Braat appealed from the decision of the Board of Patent Appeals and Interferences affirming the rejection of claims 8-10, 13, and 15-17 of the Braat application entitled "Record Carrier with Optically Readable Phase Structure and Apparatus for Reading," on the grounds of obviousness-type double patenting in view of commonly-assigned U.S. Patent No. 4,209,804 (Dil). The crux of Braat's appeal came down to whether the Board erred in applying a "one-way" patentability determination instead of a "two-way" determination. Holding that a "two-way" determination was applicable under the circumstances presented by Braat, the Federal Circuit reversed the obviousness-type double patenting rejection.

The circumstances presented by Braat are strikingly similar to those of this case. In Braat, as here, Braat first filed a foreign (Netherlands) application April 3, 1978, a U.S. application on July 17, 1978 and a second U.S. application (continuation) on January 10, 1984. The Dil patent issued June 24, 1980, on an application filed January 31, 1979. Both the Braat application and the Dil patent were concerned with optical record carriers that store information which can be retrieved by scanning the record carrier with a laser beam.

The Braat application was concerned with the ability to increase the amount of information which can be stored on a record carrier. The Braat application discloses a way to reduce the effect of "cross-talk," so that even if more than one track is inadvertently illuminated, the apparatus would still accurately read the stored information. Braat did this by alternating the "phase depth" of adjacent track portions and then using two different detection systems, one particularly sensitive to the signal from track portions of one phase depth and the other being sensitive to the signal from track portions of the other phase depth. As a result, the tracks could be placed closer together. The Dil patent was also concerned with controlling the phase depth of information areas on record carriers, but was primarily concerned with the effect that the angle of the side walls of the information areas had on the phase depth. Dil taught that a particularly useful record carrier is one which had V-shaped information areas with (1) a phase depth in the range between 100° and 125°, and (2) side walls whose angle of inclination is in the range between 65° and 85° (relative to the normal to the carrier surface). Dil recognized that this improvement was particularly useful when combined with the invention of the Braat application, which Dil specifically referred to, and so disclosed and claimed an embodiment wherein alternating track portions had different phase depths, and the information areas had angled side walls.

On appeal, Braat characterized the invention of Dil as an improvement over the invention of the Braat application, citing 3 D. *Chisum Patents*, §9.03 [2] [c] (1990), entitled "Generic Claim Issuing After Later Filed Specific or Improvement Claim," as well as *In re Borah*, 345 F.2d 1009, 148 USPQ 213 (CCPA 1966), for the proposition that when a latter filed improvement patent issues before an earlier filed basic invention, a double patenting rejection is only proper against the claims to the basic invention if the improvement is not patentably distinct from the basic invention. The Federal Circuit found it better to characterize the relationship between the inventions as combination/subcombination, i.e., Braat and Dil each developed separate subcombination inventions described by their respective independent claims, and Dil then combined these two subcombinations to form a third invention. Even so, the Federal Circuit agreed that the reasoning of *Borah* and *Chisum*, §9.03 [2] [c] was applicable, because the common owner:

"Philips could not have included the claims of Dil in the Braat application, for Braat did not invent the subject matter of the Dil claims, i.e., information areas having V-shaped side walls at particular angles of inclination. Nor could

Philips have included the claims of Braat in the Dil application, for Dil did not invent the subject matter of the Braat application, i.e., adjacent track segments of different phase depth. Philips filed the Braat and Dil applications so as to maintain proper inventorship, with claims directed to Braat's "subcombination" invention in the first application and claims directed to both Dil's "subcombination" invention and to the "combination" invention in the second application. Philips even acknowledged in Dil's application that part of the combination invention was invented by Braat, not Dil. It is not Phillips' fault that the combination claims in the Dil patent issued first. Thus, a double patenting rejection is sustainable here only if claims 5/1 and 6/1 of Dil are not patentably distinct from the subject matter defined by the rejected claims of Braat, and the Board erred in sustaining the double patenting rejection without making such a "two-way" determination."

As our predecessor court pointed out in Borah, in analogizing the Stanley decision, "We see ... that as a matter of law the extension of protection objection is not necessarily controlling." 354 F.2d at 1017, 148 USPQ at 220.

Thus, only if the extension of patent right is unjustified is a double patenting rejection appropriate. There are situations where the extension is justified. See Borah; *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 USPQ 678, 681-82 (Fed. Cir. 1986). This case presents such a situation.

To the extent that the claims of the '365 patent include some compound species that the genus claims of this Application encompass, such species have not been shown to be obvious from the claims of this Application. Hence, under the two-way test of Braat, a rejection for obviousness-type double patenting is improper. In certain cases, such as *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993), *In re Emert* 44 USPQ2d 1149 (Fed. Cir. 1997) or *In re Berg* 46 USPQ2d 1226 (Fed. Cir. 1998), an applicant may have undertaken a course of action that disqualifies his application from the two-way test for determining obviousness-type double patenting. In *Goodman*, applicant took allowance of species claims as an early issued patent and rather than appeal the rejection of his genus claims applicant continued prosecution of his genus claims in a continuation application. Such is not the case here. In *Berg*, the applicant choose to file a species application and a genus application on the same day having practically the same specifications and ran the risk that the species application would issue earlier. Such is not the case here. In *Emert*, the applicant prolonged the prosecution on the merits of his broader application by taking

maximum extensions of time and then filing multiple continuation applications wherein he again took maximum extensions of time, during which time an earlier filed narrower application issued as a patent. Such is not the case here.

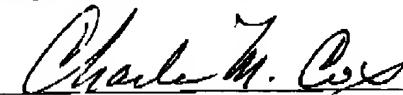
Applicant here has not engaged in any action that would disqualify this application from the application of the two-way test of *Braat* to determine whether a obviousness-type double patenting basis for rejection applies. Two-way obviousness does not exist here and the obviousness-type double patenting rejection of claims 1-6, 8 and 12-22 should be withdrawn.

CONCLUSION

It is respectfully submitted that all issues and rejections have been adequately addressed and that all claims as pending are now allowable and that the case should be advanced to issuance.

If the Examiner has any questions the Examiner is encouraged to call the undersigned at the telephone number indicated below.

Respectfully submitted,



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